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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/715,164

11/17/2003

Richard Watson

VAC.785A.US

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10/20/2008

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EXAMINER

BOGART, MICHAEL G

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/715,164 | Applicant(s) WATSON, RICHARD | |
| | Examiner MICHAEL G. BOGART | Art Unit 3761 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23, 25-41 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 25-41 and 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 21-23, 25-41 and 45-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-20 of copending Application No. 11/200,837. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '837 application claims every material limitation of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 21-23, 25-41 and 45-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 11/004,586. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '586 application claims every material limitation of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 21-23, 25-41 and 45-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-62 and 64-84 of copending Application No. 10/818,468. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '468 application claims every material limitation of the instant invention..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-23, 25, 26, 29-34, 37-41 and 45-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt *et al.* (GB 2 307 180 A; hereinafter: "Hunt") in view of Maher *et al.* (US 5,549,585 A; hereinafter: "Maher"), Aldecoa *et al.* (US 4,996,128; hereinafter: "Aldecoa"), and Ohira *et al.* (US 5,945,004 A; hereinafter "Ohira").

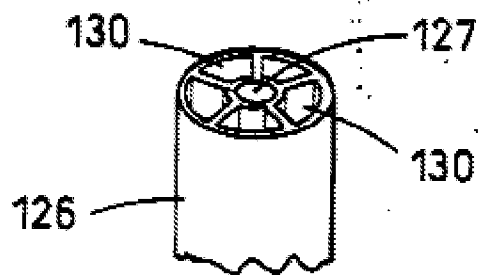
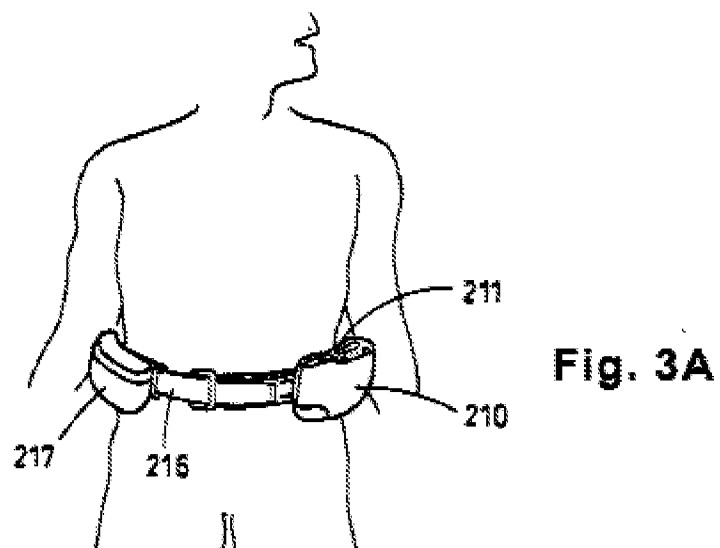
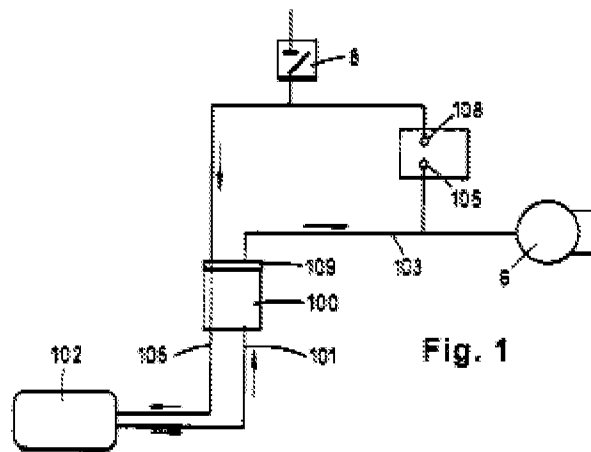
Regarding claims 21, 41 and 48, Hunt teaches a personally portable vacuum desiccator (210) for collecting and storing liquid exudate comprising:

a removable cartridge (100) having an interior chamber, a perforated (127, 130, 606,607) gas flow channel (126), an inlet and outlet ports (32, 33);

a vacuum pump member (6) in gas/liquid communication (103) with the outlet port (33) of the chamber;

a motor (6A) operably connected to said vacuum pump (6); and

a tube (106) having a first end in fluid communication the inlet port (32)(100)(see figures 1, 3A, 4, 5F and 6E, *infra*).



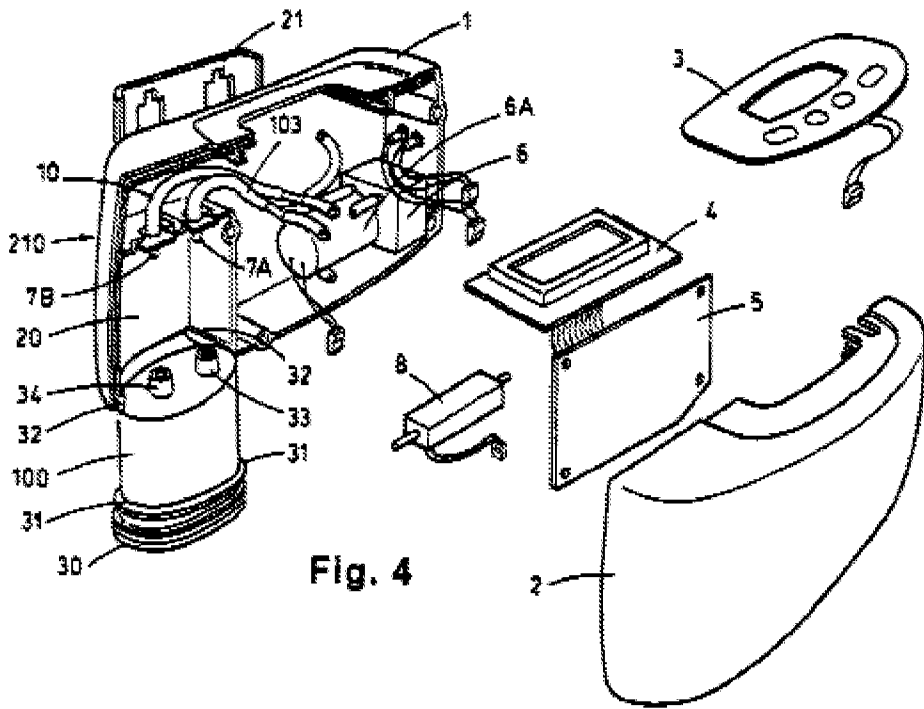


Fig. 4

Regarding the perforated gas flow chamber, see figures 5F and 6E, supra. Perforated is interpreted herein as meaning something with holes in it. perforated. (2008). See *Merriam-Webster Online Dictionary*. Retrieved October 14, 2008, from <http://www.merriam-webster.com/dictionary/perforated>.

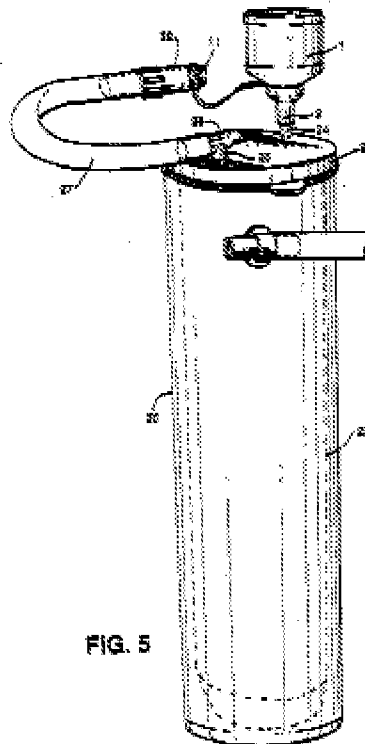
Hunt thus teaches the claimed invention except for the trapping agent in the chamber, the planar battery shape and the unidirectional inlet port. Hunt further teaches a battery contained in the unit (page 2, lines 9 & 10).

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Maier teaches a bodily fluid collect receptacle (20) to which an absorbent gelling treatment is added to the interior thereof to solidify liquid exudates. This avoids hazards associated with spillage (abstract)(see fig. 5, infra).

Ohira teaches a one-way check valve in entrance port (22). This prevents unwanted reverse flow of liquid out of the container (col. 13, lines 42-49)(see fig. 2, infra).

Regarding the functional limitations of the claims, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114.



Aldecoa teaches a slim planar battery (20) that is shaped for insertion into compact personal electronic devices (abstract)(see fig. 1, infra).

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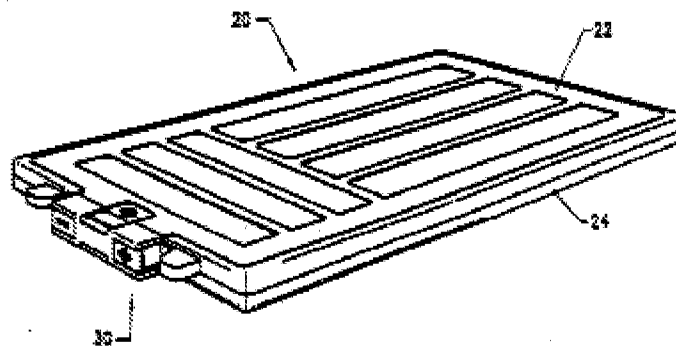
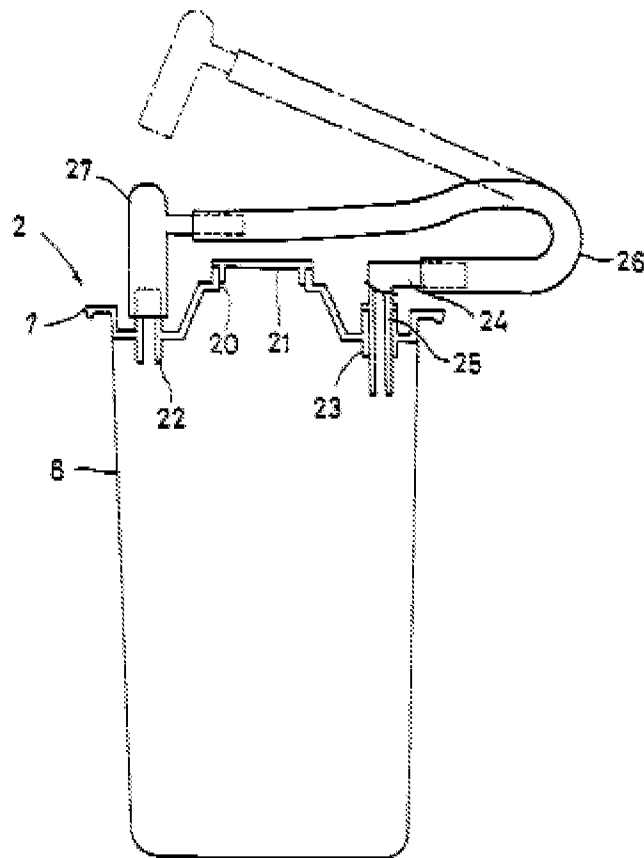


FIG. 1



At the time of the invention, it would have been obvious to one of ordinary skill in the art to add the absorbent additive of Maher to the canister of Hunt in order to resist sloshing or spillage. It would have been obvious to further select the compact battery design of Aldecoa for its portability and to add the check valve of Ohira in order to prevent unwanted backflow of liquid.

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

Regarding claim 29, Hunt teaches a gas flow channel (8).

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Regarding claims 37 and 45, Hunt teaches a filter (109) located at the outlet port.

Regarding claims 22 and 30, Maher teaches a trapping agent that is an absorbent (col. 2, lines 19-27).

Regarding claims 23 and 31, Hunt teaches a tube (101) comprising a single passage flow path (see fig. 1, supra).

Regarding claim 32, Maher teaches a trapping agent disposed in a removable cartridge (1).

Regarding claims 25 and 33, Hunt teaches a control circuit (105) which controls the motor (6A) and pump (6)(col. 6, lines 6-11).

Regarding claims 26 and 34, Hunt teaches a pressure sensor (105).

Regarding claim 49, Hunt discloses an optical displacement gauge (105)(LCD)(page 6, lines 6-11).

5. Claims 27 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt, Maher, Aldecoa and Ohira in view of Lichtenstein (US 4,464,172).

Hunt, Maher, Aldecoa and Ohira do not teach an I/O unit.

Lichtenstein teaches an automated medical care system that employs a pressure sensor (PS2) and an I/O circuit (101). At the time of the invention, it would have been obvious to one of ordinary skill in the art to add these elements to the device of Hunt, Maher, Aldecoa and Ohira in order to automate its functions. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the

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known pressure valve system to release the inner core after a predetermined time has elapsed."

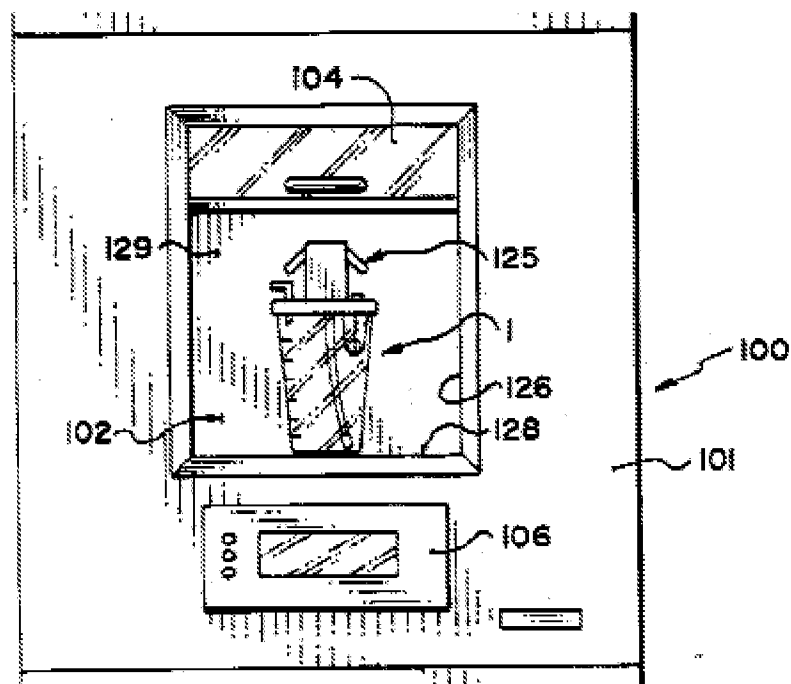
The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

MPEP § 2144.04 (III).

6. Claims 28 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt, Maher and Aldecoa in view of Walker (US 5,741,237 A).

Hunt, Maher, Aldecoa and Walker fail to claim a limitation where the chamber is transparent. Walker teaches that it is known in the art to use transparent canisters (1) for containing such material in order to visually inspect its content without opening the device (see fig. 2, infra).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to add the transparent feature of Walker to the device of Hunt, Maher, Aldecoa and Ohira in order to allow such a person to visibly see the interior of the device.



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7. Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt, Maher, Aldecoa and Ohira and further in view of Hacikyan (US 6,530,472 B2).

Hunt, Maher, Aldecoa and Ohira do not disclose a mesh trapping agent. Hacikyan discloses an anti-leak container that employs a mesh trapping agent to avoid spillage or contamination (col. 4, lines 26-43).

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a).

Ex Parte Smith, supra.

Response to Arguments

Applicant's arguments filed 11 April 2008 have been fully considered but they are not persuasive.

8. Applicants assert that neither Hunt, Mahar, Alecoa nor Ohira teach or suggest a perforated gas flow channel. This argument is not persuasive because Hunt discloses a perforated gas flow chamber (126)(see the detailed rejection supra and figures 5F & 6E). The claims must be given their broadest reasonable interpretation. MPEP § 2111. A dictionary definition of "perforated" includes something with holes in it. See *Merriam-Webster Online Dictionary*. Retrieved October 14, 2008, from <http://www.merriam-webster.com/dictionary/perforated>. Hunt's tube (126) has longitudinally extending holes that are capable of permitting gas flow therethrough. Applicants' specification does not provide a specific definition that precludes this interpretation of "perforated."

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9. In response to applicant's argument that Mahar teaches disconnecting the vacuum source from the liner (23) so that waste-treating material may be inserted into the liner, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

10. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. BOGART whose telephone number is (571)272-4933. The examiner can normally be reached on M-F, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Bogart/
Examiner, Art Unit 3761

***/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761***